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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/073,598

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09/09/2009

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EXAMINER

MOSSER, ROBERT E

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

09/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/073,598 | Applicant(s) BEAULIEU, NICOLE | |
| | Examiner ROBERT MOSSER | Art Unit 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7-12,14,15,18-22,33,35,36,39-41,43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7-12,14,15,18-22,33,35,36,39-41,43 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 13th, 2009 has been entered.

Affidavit submitted under 37 CFR 1.131

The affidavit filed on July 23, 2009 under 37 CFR 1.131 has been considered but is ineffective to overcome the Joshi (USP 6,485,367) reference.

A. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Joshi (USP 6,485,367) reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

I. The affidavit and attached evidence fails to demonstrate a correlation between the claimed invention, and the evidenced disclosure of the invention. The attached exhibits instead presents a general concept of employing a quick pick

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type feature as found in Keno in other type of selection environments and are silent to the exemplary feature of the utilization of game rules in making an automated selection according to the optimal strategy.

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it. In re Tanczyn, 347 F.2d 830, 146 USPQ 298 (CCPA 1965). (MPEP 715.02)

B. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Joshi (USP 6,485,367) reference to either a constructive reduction to practice or an actual reduction to practice.

I. From April of 2001 till November of 2001 there is no accounting for diligence. Specifically there exists a 7 month period during which the written description of the invention was forwarded to the applicant's representative and the applicant's representative presented the initial draft of the application that has not been accounted for. (MPEP 2138.06). The applicant must account for the relevant time at least from before the July 27, 2001 date of Joshi to the filing of the application.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. (MPEP 715.07(a))

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II. The Affidavit submitted under 1.131 includes addition multiple lapses of continuity from the date of July 27, 2001 to the constructive reduction of practice and according fails to establish diligence (See element .B.I. above).

III. Work relied upon to demonstrate diligence must be directly related to the reduction to practice of the invention in issue (MPEP 2138.06). It is unclear how items 8, 12, and 13 directly relate to the constructive reduction of practice of the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1, 3, 7-9, 12, 14, 18-20, 33, 35, 39-41, and 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178 and Joshi (USP 6,485,367).

The combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), and Bennett '178 teach the above listed claimed features as determined by the Patent Board Appeals in the decision rendered March 10th, 2008 incorporated herein by reference however the Board decision is silent regarding the newly amended features directed *to the automated selection being made according to the rules of the game being played and according to a strategy to optimize the likelihood that said person will receive a value payout.*

The above presented feature however is taught by the reference of Joshi (Figure 7, Col 8:56-9:18). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the optimized auto-selection feature of Joshi into the combination of Bennett '102 , Appellant's Admitted Prior Art , and Bennett '178 in order to enable the player to select a default selection of the Applicant's admitted prior art without sacrificing optimal game actions.

Claims **4, 15, 36, and 44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, Mayeroff, and Joshi (USP 6,485,367).

The combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, and Mayeroff teach the above listed claimed features as determined by the Patent Board Appeals in the decision rendered March 10th, 2008 incorporated herein by reference.

Claims **10-11**, and **21-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, Walker and Joshi (USP 6,485,367).

The combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, and Walker teach the above listed claimed features as determined by the Patent Board Appeals in the decision rendered March 10th, 2008 incorporated herein by reference.

Response to Arguments

Applicant's arguments filed July 13th, 2009 have been fully considered but they are not persuasive.

The applicant's remarks of July 13th, 2009 present the elements of the Affidavit submitted under 37 CFR 1.131 in interest of pre-dating the Joshi reference and rely solely thereon. Respectfully, the affidavit is found to contain the issues presented above in the section entitled "Affidavit submitted under 37 CFR 1.131" and is accordingly non-persuasive

Based on the above, the rejection of record is maintained.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art
Unit 3714

/R. M./
Examiner, Art Unit 3714